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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/813,966)
Inventor: Thoele, Sherwood) Ex. P. Kumar
Filed: March 31, 2004) Art Unit 1751
Title: Enzymatic Cleanser)

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Response to Election Requirement of June 27, 2006

Now comes Applicant and through the undersigned, responds as follows:

The Examiner has restricted the claims to six Groups which she lists as follows:

- I. Claims 1 – 14
- II. Claims 15 – 34
- III. Claims 35 – 45
- IV. Claims 46 – 49
- V. Claims 50 – 72
- VI. Claims 73 - 81

Applicant disagrees with the Election requirement noted above and his election is with traverse. For the purpose of complying with the requirement applicant elects the claims on Group I which the Examiner lists as including claims 1 through 14 but, for reasons that follow, it is submitted that the claims of Group II, claims 15 through 34 and Group V, claims 50 through 72, are properly included in this selection. Thus, at the very least, claims 1-34 and 50-72 are properly included in the elected invention. It is agreed below that the restriction requirement should be withdrawn and an examination of all the claims performed.

Applicant disagrees with the restriction requirement for several reasons.

The first basis for disagreement is obvious in that all six Groups denoted by the Examiner are classified in the same subclass, namely 393, of the same Class, namely 510. One of the bases for a restriction requirement is that the Examiner may have to search many different classes to examine a set of claims. In this case the only subclass the Examiner would have to search is subclass 393 of Class 510. This hardly seems like it justifies a restriction in and of itself. It is submitted that the Examiner is being too ritualistic in her approach to this restriction. The claims can easily be searched in the one subclass and are interrelated in that the compositions of Groups I, II and V are related and not disparate so as to force separate searches. They are merely describe slightly different compositions which are merely embodiments of the main invention of the base composition. Contrary to the Examiner's comments the inventions are not unrelated but are merely the same cleanser with slightly different composition ingredients but, (1)

they essentially contain the same ingredients and (2) are used for the same purpose, namely cleaning medical instruments and devices, and removing protein and carbohydrate materials from them. The product claims of the three groups all work to clean medical instruments of proteins and carbohydrate materials so Since all the described formulas are (1) close in composition sharing common ingredients for the most part, (2) are used for the same general purpose and (3) address the same problem, i.e., removing protein and carbohydrate materials from medical instruments, they cannot be said to be “unrelated”. Indeed, such a comment is incorrect from a view of the disclosure itself and thus there is no proper basis for this restriction between the three composition claims. The search for one would entail the same work as the search for all three as it is confined to the one subclass for all three compositions. The Examiner has failed to show how these amount to separate inventions by specifically pointing to the distinctions and not variations of the same invention. She cannot make just general allegations in a restriction requirement, MPEP. The claimed compositions are merely combinations and sub-combinations, not separate inventions. For instance, claims 1 and 50 are merely sub-combinations of claim 15.

In regard to the claims of Groups III and VI they merely describe the method of making the composition of this application in a simple manner. What would the Examiner have to consider with the claims of this Group that she would not have to consider with the claims of the three composition Groups of I, II, and V? The answer is nothing. The prior art describes compositions and how they are made. That is normal in any patent in this Class and Subclass. The claims in the two Groups claim essentially the same steps and therefore the search for one would be identical to the other.

Furthermore the search is limited to one subclass. Both the claimed inventions of Group III and VI are methods to make essentially the same composition with minor changes. The Examiner is required to state exactly how these methods are different and amount to different inventions and not to make general allegations without substance.

None of the designated groups are unrelated or have different modes of operation and effects. The mode of operation and effect are the same for the three Groups I, II and V and the operation for the method of making the composition is almost identical. The method of use in Group IV must use the products of Group I, II and V. the Examiner's comments stating " Since the product is not allowable, restriction is proper between the method of making and method of using" is not understood and is deemed confusing. The thoughts of the Examiner on this reasoning need further explanation.

In general, the Examiner did not show that the "inventions" are independent or distinct" as she alleges. There is no detailed explanation provided in this restriction, just broad allegations.

For the record, in regard to the telephone call, the undersigned did call the Examiner back and left a message but did not receive a return call from the Examiner.

Finally, it is submitted that the Examiner's statement in the last paragraph of page 3 of the Office action is not supported by the disclosure since the inventions have not "acquired a separate status in the art" due to their divergent subject matter. Indeed, the

subject matter is closely related and not divergent at all. How can the compositions of Groups I, II and V be said to be "divergent"? Again, it is respectfully submitted that the Examiner is misapplying the restriction requirement applicability in this application.

Accordingly, the Examiner is requested to withdraw the restriction requirement and proceed with examination of all the claims presently in the case.

If the Examiner wishes to discuss this further she is invited to call the undersigned at his Northern Virginia Office at (703) 754-1860.

Respectfully submitted,

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Certificate of Mailing

I, James W. Hiney, do hereby certify that an executed copy of this response, was deposited with the U. S. Postal Service, Express Mail No EQ 536876813 US prepaid and addressed to the Commissioner for Patents at the above address, this 17th day of July, 2006.

James W. Hiney